

## **REMARKS**

Claims 1-86 are pending in the Application. Claims 1, 2, and 7 have been amended. Claims 83-86 have been added. No new matter has been added. Entry of the amendment is respectfully requested. Reconsideration is respectfully requested.

### **Request For Acknowledgment Of Provisional Applications**

This application claims the benefit of U.S. Provisional Application Nos. 60/180,490 filed February 5, 2000 and 60/250,269 filed November 30, 2000. Acknowledgment thereof is respectfully requested.

### **The 35 U.S.C. § 112, Second Paragraph, Rejections**

Claims 1-82 have been rejected under 35 U.S.C. § 112, second paragraph, as failing to specifically claim what Applicants regard as the invention. The Action alleges that the independent claims are too broad. The Applicants respectfully traverse the rejections.

The Action is silent as to how the claims fail to specifically claim what Applicants regard as the invention. Applicants respectfully decline to speculate. The claimed subject matter can be understood by one having ordinary skill in the art. The claims are not indefinite.

Also, it is unclear how the Action can allege the claims as being too broad, especially in the absence of a 35 U.S.C. § 102 rejection, and further especially when the 35 U.S.C. § 103 rejection (i.e., the only art rejection) requires plural references. Applicants respectfully submit that the evidence of record in contrary to the Action's allegation.

The claims meet the statutory requirements of 35 U.S.C. § 112, second paragraph. Thus, it is respectfully submitted that the 35 U.S.C. § 112, second paragraph, rejections should be withdrawn.

### **The 35 U.S.C. § 103 Rejections**

Claims 1-82 were rejected under 35 U.S.C. § 103(a) as obvious over De Leo (US 6,381,626) in view of Monteiro (US 5,778,187). Applicants respectfully traverse the rejections.

Applicants traverse the rejections on the grounds that Applicants' claims recite features and relationships which are neither disclosed nor suggested in the prior art, and because there is no teaching, suggestion, or motivation cited so as to produce Applicants' claimed invention. The features recited in Applicants' claims patentably distinguish over the applied references.

For reasons of brevity the Applicants have not necessarily presented all the reasons as to why the applied references do not render the claims obvious. Applicants reserve the right to later present additional reasons. Nevertheless, Applicants' arguments show that the applied references neither taken alone nor in combination disclose or suggest all of the features and relationships of the claimed invention. Therefore, it is respectfully submitted that the 35 U.S.C. § 103(a) rejections should be withdrawn.

#### **Claim 1**

Neither De Leo nor Monteiro, taken alone or in combination, teach or suggest the recited features and relationships. Where does either of the references teach or suggest both dispensing currency responsive to a first user input and dispensing a digital information file responsive to a second user input?

Where does De Leo teach or suggest a second user input? In De Leo a non-transaction message is displayed in response to transaction approval by the host (col. 2, lines 9-15; col. 8, lines 18-21; Figure 4). After all of the transaction data has been entered by the user, then a transaction approval request containing the user entered data is sent to the host (col. 7, lines 5-21, particularly lines 18-21). After the transaction is approved by the host, a signal is sent to the terminal causing the display of a non-transaction message (col. 7, lines 47-50).

De Leo specifically teaches that it is not preferable to display a non-transaction message prior to transaction approval. Nevertheless, even if a message were displayed prior to transaction approval, it would still be displayed after all user transaction inputs are completed (col. 8, lines 14-16). Thus, De Leo does not teach or suggest a first user input for currency dispensing and a second user input for digital information file dispensing. The activities in De Leo occur after completion of the user input. The activities in De Leo are responsive to the same user input.

De Leo's user inputs are (at best) directed to a terminal transaction, e.g., cash dispensing. Where does De Leo teach or suggest a user input that corresponds to a digital information file, especially a second user input?

Monteiro cannot alleviate the recited features not found in De Leo. Monteiro is directed to multicasting using a communications network such as the Internet. Monteiro is non analogous art. For example, Monteiro is not directed to dispensing currency. Monteiro does not teach or suggest dispensing cash as alleged (Action page 2) at col. 2, lines 1-24, nor does Monteiro even mention cash or currency. Monteiro also does not teach or suggest a user input that corresponds to a digital information file, especially a second user input. It follows that Monteiro (like De

Leo) does not teach or suggest both dispensing currency responsive to a first user input and dispensing a digital information file responsive to a second user input.

Furthermore, even if it were somehow possible for Monteiro to have disclosed the features as alleged, it still would not have been obvious to have modified the references as alleged. Nor does the Action explain how De Leo or Monteiro could be modified as alleged, especially to overcome the deficiencies therein. Since the Action does not explain the rejections with reasonable specificity it also procedurally fails to establish a *prima facie* case of obviousness. *Ex parte Blanc*, 13 USPQ2d 1383 (Bd. Pat. App. & Inter. 1989).

Additionally, even if it were somehow possible (which it isn't) to have modified the references as alleged this would not render the resultant combination obvious because the prior art does not suggest the desirability of the modification (MPEP § 2143.01). The Action is devoid of any teaching, suggestion, or motivation for modifying the references to have produced the recited invention. Nor does De Leo or Monteiro have any need of modification.

Furthermore, even if it were somehow possible (which it isn't) for the references to be modified as alleged, the resultant combination still would not have produced Applicants' recited invention. That is, the above noted deficiencies in each of De Leo and Monteiro would still remain. For example, even if the references could somehow be combined as alleged, the result still would not teach or suggest both dispensing currency responsive to a first user input and dispensing a digital information file responsive to a second user input.

The only suggestion for the recited features and relationships is found in Applicants' own novel disclosure. It follows that the alleged modification of De Leo in view of Monteiro is based

on hindsight reconstruction of Applicants' claimed invention, which is legally impermissible and does not constitute a valid basis for a finding of obviousness. *In re Fritch*, supra.

The record lacks substantial evidence support. *In re Zurko*, supra. Nor does the Action factually support any *prima facie* conclusion of obviousness. To establish *prima facie* obviousness, it must be shown that all the elements and relationships recited in the claim are known in the prior art. As previously discussed, the Office has not met this burden. If the Office does not produce a *prima facie* case, which is the current situation, then the Applicants are under no obligation to submit evidence of nonobviousness (MPEP § 2142). Neither of the references, taken alone or in combination, disclose or suggest the recited features and relationships. It follows that it would not have been obvious to one having ordinary skill in the art to have modified the references as alleged to have produced the claimed invention. Thus, Applicants respectfully submit that the 35 U.S.C. § 103(a) rejections should be withdrawn.

#### **Claim 7**

Note Applicants' remarks in support of the patentability of claim 1. Neither of the references, taken alone or in combination, disclose or suggest an automated transaction machine that includes both a cash dispenser that can deliver cash responsive to input and an output device that can cause the delivery of digital content responsive to input of a digital content delivery fee authorization.

It would not have been obvious to have modified De Leo with the teaching of Monteiro to have produced the recited apparatus. Neither De Leo nor Monteiro, taken alone or in combination, disclose or suggest the recited features and relationships. The Office has not established a *prima facie* showing of obviousness.

## **The New Claims**

### **Claim 85**

Neither De Leo nor Monteiro, taken alone or in combination, disclose or suggest the recited apparatus. Neither of the references, taken alone or in combination, disclose or suggest an automated transaction machine that can receive currency dispense input, digital file selection input, payment input, and includes both a currency dispenser device that can dispense currency responsive to user input and a file dispenser device that can cause the dispense of a selected digital file responsive to user input.

### **Claim 86**

Neither De Leo nor Monteiro, taken alone or in combination, disclose or suggest the recited apparatus. Neither of the references, taken alone or in combination, disclose or suggest receiving a digital file selection input at an automated transaction machine, receiving payment input for the selected digital file, and dispensing the selected digital file.

## **The Dependent Claims**

Each of the dependent claims depends directly or indirectly from an independent claim. The Applicants have shown independent claims to be allowable. "If an independent claim is nonobvious under 35 U.S.C. § 103, then any claim depending therefrom is nonobvious" (MPEP 2143.03). *In re Fine*, 5 USPQ2d 1596 (Fed. Cir. 1988). Thus, it is asserted that the dependent claims are allowable on the same basis.

Furthermore, each dependent claim additionally recites specific features and relationships that patentably distinguish the claimed invention over the applied art. None of the references,

taken alone or in combination, discloses or suggests the features and relationships that are specifically recited in the dependent claims. Thus, it is respectfully submitted that the dependent claims are further allowable due to the recitation of such additional features and relationships.

#### **Fees For Additional Claims**

Please charge the fees associated with the submission of two additional independent claims (\$168) and four claims in excess of twenty claims (\$72) and any other fee due to deposit account 09-0428.

#### **Conclusion**

Each of Applicants' pending claims specifically recite features and relationships that are neither disclosed nor suggested in any of the applied prior art. Furthermore, the applied prior art is devoid of any such teaching, suggestion, or motivation for combining features of the applied art so as to produce Applicants' invention. Allowance of all of Applicants' pending claims is therefore respectfully requested.

The undersigned will be happy to discuss any aspect of the Application by telephone at the Office's convenience.

Respectfully submitted,



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